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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,467	12/27/2001	Kenny L. Phelps	00529-P0202B	9797

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/033,467

Applicant(s)

PHELPS ET AL.

Examiner

Geoffrey L. Knable

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6 and 7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. Claims 6-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for forming an anti-tack rubber from a blend of rubber and a chlorosulfonated polyethylene as the anti-tack composition, does not reasonably provide enablement for broadly blending rubber with any anti-tack composition that yields an anti-tack rubber with "suitable curing and anti-tack properties for use with the inflatable bladder in manufacturing pneumatic tires" as claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

In other words, the original disclosure is not considered to provide sufficient disclosure or guidance to the artisan to develop suitable and effective anti-tack rubber materials consistent with the scope of claims 6-7 for any but the disclosed chlorosulfonated polyethylene "anti-tack composition" without an undue burden of experimentation. That is, it is considered that there is insufficient predictability in terms of the anti-tack characteristics as well cure properties, etc. when selecting among materials for the "anti-tack composition" for the artisan to practice the invention over the scope of claims 6-7 without an undue burden of experimentation.

2. Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, reference is made to an "anti-tack rubber" that has "suitable curing and anti-tack properties for use with the inflatable bladder in manufacturing pneumatic tires" - it however is not considered that this defines the scope of the claim in a

Art Unit: 1733

sufficiently definite manner. In other words, it is not clear that the artisan is reasonably apprised of the metes and bounds of protection afforded by this language. In particular, how is one to determine what is and is not "suitable" anti-tack and curing properties? As such, these claims are considered to be indefinite.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 6-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hergenrother et al. (US 5,552,483) or Hunt (US 5,213,823) or GB 1,040,271 to Goodyear.

Hergenrother et al. teaches forming a tire building bladder by blending a variety of rubbers (including natural, butyl and SBR) with a block copolymer that imparts release characteristics to the composition (note esp. cols. 15-16), this rubber being applied/adhered as an outer layer for a tire building bladder - this would seem to teach or certainly render obvious what is now claimed (the ambiguity with respect to the scope of the claim necessitating this alternative 102/103 rejection). In other words, insofar as this material presumably provides a suitable and effective tire bladder including particularly suitable release properties, it would be expected to have or certainly have been obvious to provide "suitable" cure and release properties for the materials.

Hunt similarly discloses a tire building bladder formed by blending a rubber with a PVC material that apparently imparts anti-tack properties to the blend, this forming a surface layer (14) bonded to another elastomer layer. This thus likewise would seem to teach or certainly render obvious what is now claimed (the ambiguity with respect to the scope of the claim necessitating this alternative 102/103 rejection). In other words, insofar as this material presumably provides a suitable and effective tire bladder including particularly suitable release properties, it would be expected to have or certainly have been obvious to provide "suitable" cure and release properties for the materials.

GB '271 to Goodyear discloses a tire building bladder formed from or including a layer formed from (note page 5, lines 105+) a blended rubber material designed to have good release properties. Facing of a natural rubber bladder with such a material would therefore suggest or certainly render obvious what is now claimed (the ambiguity with respect to the scope of the claim necessitating this alternative 102/103 rejection). In other words, insofar as this material presumably provides a suitable and effective tire bladder including particularly suitable release properties, it would be expected to have or certainly have been obvious to provide "suitable" cure and release properties for the materials.


As to claim 7, the bladders in these references are initially formed of uncured rubber sheets which are cured. Such curing, as is well known, is typically performed under heat and pressure, this teaching or certainly rendering obvious the use of an autoclave as claimed.

Note: JP 0 413 305 A1 was crossed off the IDS as it is not a correct listing +no copy.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062 until 12/18/03; 571-272-1220 thereafter. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
November 28, 2003